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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,796	02/12/2001	Robert Sesek	10003563-1	3420

22879 7590 12/18/2003

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EXAMINER

LEE, CHEUKFAN

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,796

Applicant(s)

Examiner

Cheuk fan Lee

Group Art Unit

2622

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2-12-01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-24 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 11-13 is/are allowed.
- ☒ Claim(s) 1, 3-6, 10, 14, 15, and 17-24 is/are rejected.
- ☒ Claim(s) 2, 7-9, 16 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftperson's Patent Drawing Review, PTO-948 ☐ Other _____

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1. Claims 1-24 are pending. Claims 1, 11, 14, 17, and 24 are independent.
2. Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

In claims 18 and 19, "said determining step" lacks antecedent basis. It is unknown what determining is referring to.

Claims 20 and 21 are rejected as being dependent upon the rejected claims 18 and 19.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 1, 3-6, 10, 14, 15, 17, 18,²³ and ~~23~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Kurata et al. (U.S. Patent No. 4,518,999).

Regarding claim 1, Kurata et al. discloses all subject matter claimed. An apparatus comprising a first set of slidable cursors (23 and 24) slidably moved in the Y-direction (defined to be the main scanning direction) for defining positions (coordinates) of a scan area along the Y-direction. With respect to the X-direction defined to be the subscanning direction, which is parallel to the Y-direction, the paragraph at col. 4, lines 48-54, states the following:

“Upon the completion of the positioning operation in the Y-direction in such a manner, the driving of a step motor (not shown) is started. Then the displacing of the reading unit 29 in the X-direction is initiated so that the reading of original document from a part designated with respect to this direction by another mechanism is performed.”

In the above paragraph, the “another mechanism” is understood to mean another or second set of slidable cursor(s) that designates a part or area of the document in the X-direction (subscanning direction). This second set defines coordinates of the designated part of scan area of the document (col. 4, lines 48-61, Figs. 3 and 4, col. 2, line 55 - col. 3, line 38).

The first and second sets of cursors generate signals indicative of the coordinates corresponding to the first set and signals corresponding to the second set, respectively. Note that the electronic circuit section (Fig. 5) generate signals or positional data (57, 61, etc.) with respect to the starting point and end point in the Y-direction and with respect to the starting point and end point in the X-direction (col. 3, line 39 - col. 4, line 47).

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Further, a control interface is inherent in the electronic circuit section (Fig. 5) that initiates and controls a scan operation responsive to a scan signal received (from start button, col. 4, lines 1+). The coordinate indicating signals (positional data) are communicated to the inherent control interface (col. 4, lines 1-61).

Regarding claims 3 and 4, according to Fig. 3 of Kurata et al., the first set of cursors (slidable in the Y-direction or main scanning direction) comprises two cursors that are located and retained in a first recess (Figs. 3 and 4) extending along the Y-direction or Y-axis. The two cursors are independently slidable. The positional difference between the two cursors is one dimension of the scan area. Based on the discussion above with respect to the X-direction (main scanning direction) or X-axis, two cursors are located and retained in an inherent second recess extending along the X-axis, which are independently slidable in the X-direction, and the positional difference between these two cursors is the dimension of the scan area.

Regarding claim 5, according to Fig. 4, the cursors (23 and 24) comprise a relatively flat bar that extends from its respective recess a substantial distance onto the scanable surface of document glass (21 in Fig. 4) to enable a user to closely identify the location of the coordinate or position being defined.

Regarding claim 6, the claim claims "a pointer". The cursor (23 or 24) having a pointing or protruding portion (23B or 24B) reads on the claimed "pointer".

Regarding claim 10, the start button (not shown) of Kurata et al. (col. 4, line 4) reads on the claimed switch.

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Regarding claims 14 and 24, the corresponding method and apparatus is also met by Kurata et al. because when the slidable members or cursors (23) are used to define a scanning area, the controller inherently determines whether the defined scan area is the entire scan area or just a portion of the entire scan area and controls the scanning depending on the result.

Regarding claim 17, Kurata et al. discussed for claim 1 above meets all limitations of claim 17. It is inherent that the plurality of cursors are selectively positioned to define the scan area, depending on the user's desire on the size or dimension of the scan area to be scanned.

Regarding claim 18, only the positioning step and the scanning step are understood to be included in the claim, not the determining step. The claim recites "wherein said positioning and scanning steps comprise functionality that can be selectively enabled and disabled. To this extend of the claim, in Kurata et al., turning off the apparatus disables such functionality, and turning on the apparatus enables such functionality.

Regarding claim 15, see discussion for claim 18.

Regarding claim 23, see discussion for claim 14.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurata et al. (U.S. Patent No. 4,518,999) in view of known art.

Regarding claim 22, Kurata et al. discussed for claim 17 above does not specifically disclose sending a constructed digital file of the scan area to a previously specified destination. However, Kurata et al. in the background of the invention section states "The present invention relates to a picture image position setting apparatus useful in ... picture transmitting or in electronic editing." The examiner took Official Notice of the fact that creating a digital file using a scanned image, be it the whole image or a partial image, and sending the file to a previously specified destination is well known in the art. Since the invention of Kurata et al. is related to image transmitting, it is well known to send data in a digital file form. It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct a digital file of the scan area of Kurata et al. and send the digital file to a pre-specified destination as is well known in the art to enable remote processing or viewing of the file.

7. Claims 2, 7, 8, 9, 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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8. Claims 19-21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Claims 11-13 are allowed.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bromley et al. (U.S. Patent No. 5,818,610) discloses a scanner frame having a series of bars which can be detected.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee at telephone number (703) 305-4867.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

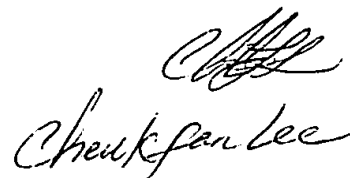
or faxed to:

(703) 872-9306 (for formal communications intended for entry)

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist)

C. L.
Dec. 10, 2003

Handwritten signature of Cheukfan Lee in cursive script.